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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/633,911	08/08/2000	Daniel J. McGurran	55282USA1B.010	4870

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EXAMINER

PAULRAJ, CHRISTOPHER

ART UNIT	PAPER NUMBER
1773	11

DATE MAILED: 01/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/633,911	MCGURRAN ET AL.
	Examiner Christopher G. Paulraj	Art Unit 1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.

- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 06 November 2002.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-16, 18-27, 29, 30 and 59-65 is/are pending in the application.

4a) Of the above claim(s) 59-65 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-16, 18-27, 29 and 30 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

**DETAILED ACTION**

1. The amendment filed on November 6, 2002 has been entered. Claims 1-16, 18-27, 29-30, and 59-65 are pending.

***Election/Restrictions***

2. Claim 59, as amended, and newly submitted claims 60-65 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The new claims, directed to a process of making a product, is considered to be a distinct invention than the product originally claimed in claims 1-16, 18-27, and 29-30. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process can be used to make films that do not have an internal haze of less than or equal to about 5%. The claims originally submitted are classified in class 428, subclass 323. The new claims are classified in class 427, subclass 1+. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 59-65 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

3. Claims 1, 4-10, 12-16, 21-27, and 29-30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fukuda et al. (U.S. Patent 4,865,898) for the reasons substantially set forth in paragraph 7 of the Office Action mailed May 30, 2002 (Paper no. 8).
4. Claims 1-6, 9-16, 18-27, and 29-30 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wheatley et al. (U.S. Patent 6,049,419) for the reasons substantially set forth in paragraph 9 of the Office Action mailed May 30, 2002 (Paper no. 8).

***Response to Arguments***

5. Applicant's arguments filed November 6, 2002 have been fully considered but they are not persuasive.
6. With respect to the Fukuda et al. reference, Applicants argue that the claimed haze value would not be inherently present in the prior art film and that one skilled in the art would not be motivated to adjust the haze levels to within the claimed range. Applicants submit that, even assuming that the exact same materials are disclosed by Fukuda et al., the process of mixing or milling the particulate pigment into an already polymerized polyester (as is done in the examples of Fukuda et al.) produces films that are much more hazy than films in which the particulate pigment is carefully added to the reaction mass before polymerization. This argument is not considered persuasive to overcome the pending rejections. While the Examiner understands that a different process of producing

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an article may result in a materially different product, Applicants have not submitted any declaration or experimental data in support of their conjecture that the product of Fukuda et al. would not meet the claimed haze values. The Examiner in the prior office action relied upon In re Spada, 911 F.2d 705 (Fed. Cir. 1990) to establish a prima facie case of inherency based upon the same materials being used within the same concentrations to make the composition. Applicants have not shown any supporting evidence to prove that the haze values would not be inherently present in the prior art. While the reference discloses that the films should desirably have excellent light shielding properties, nothing in the reference states that there should also be increased haze values above the claimed five percent.

7. With respect to the Wheately et al. reference, Applicants make the same argument with respect to the inherency of the claimed haze requirements. Absent experimental data showing otherwise, the Examiner finds this unpersuasive for the reasons stated above. Applicants have also argued that the visible light transmission associated with the pigment is not only a function of concentration but also of the thickness of the pigmented layers and of the type of pigment used. In response, the Examiner points out that the layer thickness and types of pigments disclosed in the prior art fall within what has been disclosed in the present specification. Applicants have not shown any evidence supporting their contention that the claimed transmission values would not be met in the prior art optical bodies.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher G. Paulraj whose telephone number is (703) 308-1036. The examiner can normally be reached on Monday-Friday, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703) 308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0661.

*cgp*  
cgp  
January 21, 2003

*Paul Thibodeau*  
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